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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/894,904	06/29/2001	Steven C. Monroe	06978.0105-00000	4655

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KENYON & KENYON
1500 K STREET NW
SUITE 700
WASHINGTON, DC 20005

EXAMINER

CHEN, TE Y

ART UNIT PAPER NUMBER

2161

DATE MAILED: 10/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/894,904

Applicant(s)

MONROE, STEVEN C.

Examiner

Susan Y. Chen

Art Unit

2161

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 July 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-50 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-50 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Response to Amendment

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 07/28/2005 has been entered.

Claims 21-50 are pending for examination.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 21-30 are rejected under 35 U.S.C. 101 because these claims merely recites a abstract idea for maintaining a whois database in the preamble, the steps in the claims body can be implemented by the mind of a person or by the use of a pencil and paper. In another words, because the phrase "for maintaining a whois database " does not necessarily mean that the database is actually participating in any system, thus, the claimed steps is not in the technological arts and deemed to be non-statutory.

To expedite a complete examination of the instant application the claims rejected under 35 U.S.C. 101 (nonstatutory) above are further rejected as set forth below in anticipation of applicant amending these claims to place them within the four statutory categories of invention.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 21-50, are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,760,746 issued to Schneider (hereinafter referred as Schneider '746).

Claim 21:

Schneider '746 discloses:

Maintaining a whois database in an Internet Domain Names Service system [e.g., the unit 172, Fig. 1m and associated texts], comprising:

- extracting a plurality of unique identifiers from an audit file, each unique identifier corresponding to a modified domain name record within a

registrar database [e.g. the step 610-630, Fig. 6a; the AutoSearch processing of Fig. 7]; and for each unique identifier:

determining whether a first domain name record that corresponds to the unique identifier exists within the registrar database, if the first domain name record exists, retrieving the first domain name record from the registrar database [e.g., col. 13, lines 31-42; the step 626, Fig. 6a; Fig. 6b and associated texts];

determining whether a second domain name record that corresponds to the unique identifier exists within the who is database, if the second domain name record exists, retrieving the second domain name record from the whois database [e.g., col. 13, lines 21-29; col. 25, lines 27-33; the processing of hyperlink whois request, col. 26, lines 51-56];

comparing the first domain name record to the second domain name record [e.g., col. 13, lines 43 – 52]; and

updating the second domain name record, within the whois database, based on the first domain name record [e.g., col. 35, lines 42-52; the steps: 1010-1030, Fig. 10 and associated texts].

Claim 22:

Schneider '746 further discloses:

The cited feature “deleting a second domain name record if the first corresponding domain name record does not exist”. [e.g., col. 29, lines 24-30].

Claim 23:

Schneider '746 further discloses:

The cited feature “adding a first domain name record to the whois database if the second corresponding domain name record does not exist”. [e.g., col. 23, lines 10-19].

Claim 24:

The cited feature – discarding duplicate unique identifiers from the plurality of unique identifiers -- is the nature property of unique identifier in a DSN system.

Claim 25:

The cited features – modified domain name record consists of an added domain name record, a deleted domain name record and changed domain name record – are inherent for any modification processing performed on a domain name data item.

Claim 26:

Schneider '746 further discloses:

The cited features - using an indicator to indicate the type of add, delete and change processing corresponding to a unique identifier of an audit file. [e.g., the domain name status indicator, col. 28, lines 21-24].

Claim 27:

Schneider '746 further discloses:

The audit file includes modified domain name information associated with each unique identifier [e.g. the zone files, col. 6, lines 4-7].

Claim 28:

Schneider '746 further discloses:

the plurality of unique identifiers are associated with a time period [e.g., col. 34, line 1-16].

Claim 29:

Schneider '746 further discloses:

tagging the audit file to identify previously extracted unique identifiers [e.g., the Watch list, Fig. 5].

Claim 30:

Schneider '746 further discloses:

The whois database is a copy of registrar database [e.g. the local cache 172, Fig. 1m].

As to claims 31-50, these claims recite the same features as claims 21-30 in form of computer system and computer-readable program product, hence are rejected for the same reason.

Response to Arguments

Applicant's arguments with respect to claims 21-50 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

Teare et al. (U.S. Patent No. 6,151,624) which discloses a system for navigating network resources based on metadata.

Gardos et al. (U.S. Patent No. 6,880,007) which discloses a domain manager and method of use.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan Y Chen whose telephone number is 571-272-4016. The examiner can normally be reached on Monday - Friday from 7:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic can be reached on 571-272-4023. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Susan Y Chen
Examiner
Art Unit 2161

Oct. 7, 2005


UYEN LE
PRIMARY EXAMINER